

REMARKS

Claims 45, 46 and 51 are amended herein to correct minor informalities and a typographical error. Claim 45 is further amended to delete “a hydroxyl group” in the definition of substituents R₄₁, R₄₂ and R₄₃, R₄₄. Hence, no new matter is presented. Upon entry of the Amendment, which is respectfully requested, claims 45-69 will be all of the claims pending in the application.

I. Request for Withdrawal of Finality of the Office Action dated April 21, 2003.

Applicants respectfully submit that the Office Action dated April 21, 2003, was improperly made final and therefore Applicants request the Examiner to withdraw finality of the Office Action. The Examiner states on page 4 of the Office Action that Applicants’ amendment necessitated the new grounds of rejection presented in the Office Action. The amendments to the claims were made: (1) in response to the Examiner’s rejection under 35 U.S.C. § 112, 2nd paragraph, indicating that the claims were incomplete because the definition of the “Q” substituent was omitted; (2) in response to the Examiner’s rejection under 35 U.S.C. § 112, 2nd paragraph indicating that the word “derivative” was unclear and suggestion to use the word “compound”; (3) in response to the Examiner’s rejection under 35 U.S.C. § 112, 2nd paragraph, that the claims were unclear because of the parenthesis, etc. Further, new claims 62-69 were added in response to the Examiner’s statement that method claims could be rejoined with the compound claims, which were indicated as allowable over the cited art.

Applicants submit that under such circumstances, it is not proper for the Examiner to make the next Office Action relying on newly cited art final unless amendments were made to the claims, which necessitated application of the art submitted. In this case the only substantive

amendment to the claims was made in response to rejections under 35 U.S.C. § 112, to clarify the claim language by adding the definition of the “Q” substituent, which was recited in the original claims and the disclosure and did not necessitate the application of the newly cited reference. See MPEP § 706.07(a). Specifically, it states in the MPEP:

A second or subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. (Citation omitted). One would have reasonably expected that a rejection under 35 U.S.C. § 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

Thus, since the Amendments to the claims did not affect the scope of the claims by adding limitations that were not previously presented or at least should have been anticipated by the Examiner as part of the claimed invention, it is improper to make a final rejection wherein a new rejection is made over prior art not of record. Further, the insertion of the definition of the “Q” substituent in claim 45 did not affect the scope of the claims such that the newly cited Gao et al reference could not have been applied in the first Office Action.

In addition, it is improper to make a final rejection based on newly cited art, that was not submitted as part of an Information Disclosure Statement filed with a fee, of any claim that was not amended despite the fact that other claims may have been amended to require newly cited art. MPEP § 706.07(a). In this regard Applicants point out that dependent claims 51-53 specifically relate to the “Q” substituent inserted into claim 45 in the Amendment filed on January 24, 2003, but were not amended. Thus, even if the amendment to include the “Q” substituent and its definition is considered as an amendment necessitating the new grounds of rejection (a point which Applicants do not

concede), it is improper to make the rejection final since claims 51-53 are included in the rejection over Gao et al, but were not amended.

Accordingly, Applicants respectfully request withdrawal of the finality of the Office Action dated April 21, 2003, in view of the above.

II. Claim Rejections Under 35 U.S.C. § 112, 2nd Paragraph

Claims 45-69 are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite because of the recitation of the phrase “general formula”.

Claim 45 is amended by deleting the word “general”, thereby obviating the rejection.

Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Claim Rejections Under 35 U.S.C. § 103

Claims 45-69 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gao et al (US 6,028,208). The Examiner states that the present claims differ from Gao et al by reciting a specific species and/or a more limited subgenus, particularly when R₄₃ and R₄₄ or R₄₁ and R₄₂ are OH and C₁-C₄ alkyl, m=2 and n=0 or 1. It is the Examiner’s position that it would have been obvious to one of ordinary skill in the art to select any of the species of the genus taught by the reference, including the claimed species, with a reasonable expectation that the species would have similar properties and the same use as the disclosed genus.

Applicants respectfully traverse the rejection. Applicants submit that the mere fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. A proper analysis requires a determination of whether there is motivation to select the specifically claimed compound from the disclosed genus. Some of the factors which

should be considered include (1) the size of the genus; (2) the express teachings in the reference; (3) structural similarity; and (4) teachings of similar properties or uses.

In this case the genus disclosed by Gao et al is fairly large and there are structural differences between the disclosed compounds and the presently claimed compounds. For instance, Gao et al does not teach or suggest compounds wherein Z is (1-3) and Q expresses C-F-R₃₁ or N-R₃₁, or where Z is (1-4) as recited in claim 45. In addition, Gao et al, does not teach or suggest the specific compounds of the dependent claims. Further Gao et al does not appear to disclose a specific example of a compound having the substituents as suggested by the Examiner. Therefore, the Examiner has not made a *prima facie* showing of obviousness since it has not been established on the record that the prior art suggests the desirability to modify the disclosure of Gao et al. The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Accordingly, Applicants respectfully request withdrawal of the rejection.

IV. Conclusion

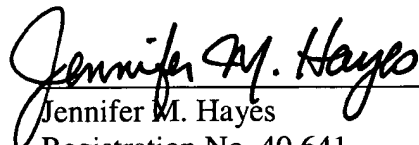
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No.: 10/035,251

Attorney Docket No.: Q67009

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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